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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/776,379

02/02/2001

Thomas A. Rhee

8077

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EXAMINER

PATEL, JAGDISH

ART UNIT

PAPER NUMBER

3624

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,379

Applicant(s)

RHEE, THOMAS A.

Examiner

JAGDISH PATEL

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/29/2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 and 9-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1,7 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 2-6 and 9-35 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicant's response filed on 12/29/2005.

Election/Restrictions

2. Applicant's election with traverse of Species 1.6 (claims 1, 7 and 8) in the reply filed on 12/29/05 is acknowledged. The traversal is on the ground(s) that subspecies 2.1-2.24 are all closely related and that all of the sub-species are in species are inter-related. This is not found persuasive because the subject matter of each species is distinct from other species. For example,

The species and sub-species (2.1-2.4) referenced in claims 11-35 recite alternate method of determining an optimal portfolio which is carried out on the basis of the investor questionnaires which is distinct from determining an optimal portfolio from investment parameters as recited in claims 1-10 and dependent claims and corresponding sub-species (1.1-1.6). Note, for example, that the investment parameters defines an identifier of an investment (financial instrument type, such as stock, bond etc., characteristics of the financial instrument such as p/e ratio, growth rate, capitalization, industry group, etc.), whereas, investor questionnaires concerns, investors own personal information (age, sex, financial goals) etc. Therefore, significantly different methodology must be applied to derive optimal portfolio on the basis of these two distinct sets of input information received from the investor.

In regards to the applicant's argument that sub-species 1.1-1.6 are inter-related. The applicant does not provide any support for this assertion. The examiner would like point out that each species have patentably distinct features not required in the other species and therefore they are mutually exclusive. For example, species 1.1 and 1.2 recite features (species 1.1 claims 1 and 2 refer to rebalancing the at least one portfolio to generate a new portfolio whereas species 1.2 claims 1 and 3 recites generating optimum scenario portfolio based on ranking investment index using Modern Portfolio Theory) recite mutually exclusive features.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 7 and 8 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Labe, JR. et al. (US 2002/0091605) (hereafter referred to as Labe).

As per claims 1, 7 and 8, Labe discloses a method of portfolio management comprising:

generating at least one optimal scenario portfolio in accordance with the investment parameters communicated through the Internet (para [0044] ..communication medium ..the Internet, para [0032]..optimal portfolio in accordance with the user's investment profile) and current market conditions and comparing expected returns of said optimal scenario portfolio with expected returns of at least one existing portfolio to provide trade recommendations. ([0052] asset allocation models, [0054] restrict the universe of assets in 36 to a certain class or number of assets, ..the elimination of the lower performing 60% of the assets ..only the highest-quality assets are being utilized..) also refer to [0060] ..set of recommended optimal or near-optimal portfolios.)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3624)

3/14/06